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10/584,788	06/28/2006	Oliver Winzenried	125542-1006	5003

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EXAMINER

COPPOLA, JACOB C

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,788	Applicant(s) WINZENRIED ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05 February 2007 and 06 May 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Preliminary Amendment filed on 28 June 2006.
2. Claims 11-30 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20080809. This Paper No. is for reference purposes only.

Restrictions

5. Restriction to one of the following inventions is required under 35 U.S.C. §121:
 - I. Claims 11-28, drawn to a method, classified in class 705, subclass 59.
 - II. Claims 29-30, drawn to a method, classified in class 705, subclass 56.
6. The inventions are independent or distinct, each from the other because:
7. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the

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instant case, subcombination Invention I has separate utility such as deciding whether an authorization code should be restored. See MPEP § 806.05(d).

8. The Examiner has required restriction between subcombinations usable together. Where Applicants elect a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 C.F.R. §1.104. See MPEP § 821.04(a). Applicants are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

9. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

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(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

10. Applicants are advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 C.F.R. §1.143) and (ii) identification of the claims encompassing the elected invention.

11. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 C.F.R. §1.144.

12. If claims are added after the election, Applicants must indicate which of these claims are readable on the elected invention.

13. Should Applicants traverse on the ground that the inventions are not patentably distinct, Applicants should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

14. If Applicants in their response to this Restriction expressly state that the Inventions I and II as noted above are not patentably distinct and should Applicants provide evidence that Inventions I and II are not patentably distinct, the Examiner may withdraw this Restriction.

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15. During a telephone conversation with Kenneth Glaser on 08 August 2008 a provisional election was made with traverse to prosecute the invention of Group I, claims 11-28.

Affirmation of this election must be made by the Applicants in replying to this Office action.

Claims 29 and 30 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

16. The Information Disclosure Statements filed 05 February 2007 and 06 May 2008 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Claim Rejections - 35 USC § 112, 2nd Paragraph

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claim 28 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

19. Regarding claim 28:

- a. This claim recites “the management computer”. This claim is indefinite because the term “management computer” lacks antecedent basis in the claim.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 11-17 and 21-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. (U.S. 2003/0074569 A1) (“Yamauchi”), in view of Murakami et al. (U.S. 2005/0144019 A1) (“Murakami”).

22. Regarding claim 21:

b. Yamauchi discloses the following limitations:

i. *reading of the license parameters belonging to the licensor from memory*
(see ¶0019 and ¶0030);

ii. *sending the read license parameters* (see ¶0030);

iii. *restoring the authorization code corresponding to the received license parameters* (see ¶0030);

iv. *returning the restored authorization code to the computer of the licensee*
(see ¶0030);

v. *storing the restored authorization code in the data-processing device connected to the computer of the licensee in a device-specific format in the data-processing device* (see figure 2 and associated text);

vi. *receiving the license parameters* (see ¶0030);

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- vii. *evaluating the license parameters* (see ¶0030); and
 - viii. *deciding whether the requested authorization code should be restored and returned to the licensee* (see ¶0030).
 - c. Yamauchi does not specifically disclose that the licensing parameters are read from a security file. Murakami, however, discloses a security file that contains licensing parameters similar to the licensing parameters that Yamauchi has stored in memory (see Murakami, figure 12 and associated text; and Yamauchi, ¶0019 and ¶0030).
 - d. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the memory of Yamauchi the security file as taught by Murakami since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.
 - e. Additionally, Yamauchi does not specifically disclose that the licensing parameters are sent to a licensor, where the licensor restores the authorization code.
 - f. Murakami, however, discloses a licensor server in communication with a customer, where the licensor server stores licensing information. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the licensor server of Murakami in place of the memory card of Yamauchi to backup the license key and to provide recovery of the license key in the event that the memory card of Yamauchi is lost, corrupted, or destroyed.

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23. Regarding claim 22:

g. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

ix. *the license parameters are signed with time information for protection and are provided in the security file* (see Murakami, figure 12 and associated text).

h. Additionally, Yamauchi/Murakami does not specifically disclose in ¶ 0030 of Yamauchi that the license parameters are provided at least partially in encrypted form in the security file. Yamauchi instead stores the information in a tamper resistant hardware structure (see figure 1 and associated text).

i. Yamauchi, however, does disclose storing licensing parameters in encrypted form outside of the security file (see figure 2 and associated text).

j. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to also encrypt the licensing parameters within the security file in order to provide additional security.

24. Regarding claim 23:

k. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

x. *sending licensing parameters stored in the security file to the licensor* (see rejection to claim 21);

xi. *evaluating the licensing parameters by the licensor* (see rejection to claim 21); *and*

xii. *generating an authorization code corresponding to the licensing parameters* (see rejection to claim 21).

l. Additionally, Murakami discloses time information stored in a security file (see figure 12 and associated text)

m. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the time information of Murakami for the licensing parameters of Yamauchi. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

25. Regarding claim 24:

n. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

xiii. *characterized in that several authorization codes for licenses of several licensors are stored on the data-processing device* (see Yamauchi, ¶0026).

26. Regarding claim 25:

o. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

xiv. *characterized in that remote data connections are established to all licensors, in order to permit the corresponding authorization codes to be restored* (see at least Murakami, figure 1 and associated text).

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27. Regarding claims 11-17, these claims are understood by the Examiner to be of substantially the same scope as claims 21-25. Accordingly, claims 11-17 are rejected in substantially the same manner as claims 21-25.

28. Claims 18-20 and 26-28, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi/Murakami, in view of Chandrasekaran et al. (U.S. 6,335,972 B1) ("Chandrasekaran").

29. Regarding claims 26 and 27:

p. Yamauchi/Murakami discloses the limitations of claim 21, as shown above.

Yamauchi/Murakami, further, discloses the limitations:

xv. *establishing a remote data connection between the computer of the licensee and licensor* (see Murakami, figure 1 and associated text);

xvi. *sending the security file to the licensor* (see rejection to claim 21); and

xvii. *establishing a data connection between the computer of the licensor and the licensee* (see Murakami, figure 1 and associated text).

q. Yamauchi/Murakami does not specifically disclose *a central management computer*.

r. Chandrasekaran, however, does disclose an intermediary central management computer (see figure 2.1 and associated text).

s. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the structure of Yamauchi/Murakami the central management computer as taught by Chandrasekaran since the claimed invention

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is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

30. Regarding claim 28:

t. Yamauchi/Murakami/Chandersekaran discloses the limitations of claims 21 and 26, as shown above. Yamauchi/Murakami/Chandersekaran, further, discloses the limitations:

xviii. *reading the serial number from the security file* (see rejection to claim 21);
and

xix. *sending the serial number to a management computer* (see rejection to claim 26).

u. Yamauchi/Murakami/Chandersekaran does not specifically disclose the following limitations:

xx. *storing the serial number in a block list at the management computer.*

v. However, Yamauchi, does disclose storing the serial number (“apparatus specific ID”) in a block list at the memory card. The Examiner has already shown that the features of the memory card as disclosed by Yamauchi may be incorporated into the licensor server of Matsushima, as shown in the rejection to claim 21. Likewise, one of ordinary skill in the art, at the time the invention was made would recognize the licensor server of Matsushima and the management computer of Chandersekaran, also a server (see figure 2.1 and associated text), as interchangeable parts. Thus, the simple

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substitution of one known element for another, producing predictable results, renders the claim obvious.

31. Regarding claims 18-20, these claims are understood by the Examiner to be of substantially the same scope as claims 26-28. Accordingly, claims 18-20 are rejected in substantially the same manner as claims 26-28.

32. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

33. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are

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directed towards beginners (see *e.g.* “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

34. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

w. Kohl et al. (U.S. 2002/0091930 A1) discloses at least a system and method to securely store information in a recoverable manner on an untrusted system.

x. Hori et al. (U.S. 2002/0131594 A1) discloses at least a reproduction device stopping reproduction of encrypted content data having encrypted region shorter than predetermined length.

y. Folmsbee (U.S. 6,308,256 B1) discloses at least a secure execution of program instructions provided by network interactions with processor.

z. Hillegass et al. (U.S. 7,062,468 B2) discloses at least a licensed digital material distribution system and method.

35. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on

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Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/
Examiner, Art Unit 3621
August 9, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621